

Applicant: FITZPATRICK  
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### REMARKS

In response to the Decision on Appeal dated **April 18, 2012** (hereinafter, "Decision") and an Office Action mailed May 6, 2008 (hereinafter "Office Action"), claims 1-22, 24-39, 50, and 51 have been amended. Claims 23, 40-49 and 52-55 have been cancelled without prejudice or disclaimer. Claims 56-69 are newly added. Therefore, claims 1-22, 24-39, 50, 51, and 56-69 are pending. Support for the instant amendments is provided throughout the as-filed Specification. Thus, no new matter has been added. In view of the foregoing amendments and following comments, allowance of all the claims pending in the application is respectfully requested.

### REJECTION UNDER 35 U.S.C. § 101

Claims 40-49, 52, and 55 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. [Office Action, pg. 4]. The Board of Patent Appeals and Interferences (hereinafter, the "Board") appears to have affirmed the rejection of claims 40-49, 52, and 55.<sup>1</sup> [Decision, pg. 5]. Applicants disagree with the propriety of the alleged rejection and affirmance for at least the reason that the Board is improperly reading limitations into 35 U.S.C. § 101 on the subject matter that may be patented. Nonetheless, solely in an effort to expedite prosecution, and in no way acquiescing in the propriety of the alleged rejection or alleged affirmance, claims 40-49, 52, and 55 have been cancelled without prejudice or disclaimer, rendering the rejections moot. Accordingly, the withdrawal of the rejection under 35 U.S.C. § 101 is earnestly sought.

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<sup>1</sup> The Board affirmed the rejection of claims 52 and 55 under 35 U.S.C. § 101 without explicitly affirming the rejection of claims 40-49. Claims 52 and 55 depend from independent claim 40, which is directed to a "price-paid database." Claims 41-48 also depends from claim 40.

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**REJECTION UNDER 35 U.S.C. § 103**

Claims 1, 2, 5-7, 9, 14-16, 18, 23-25, 28-30, 34-36, 40, 41, 44, 46, and 50-55 stand rejected under 35 U.S.C. § 103 as allegedly being unpatentable over U.S. Patent No. 4,972,504 to *Daniel, Jr. et al.* (hereinafter "Daniel") in view of U.S. Patent No. 5,873,069 to *Reuhl et al.* (hereinafter "Reuhl"). Claims 3, 26, and 42 stand rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Daniel in view of Reuhl, and further in view of U.S. Patent No. 5,918,211 to *Sloane* (hereinafter "Sloan"). Claims 4, 27, and 43 stand rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Daniel in view of Reuhl, and further in view of U.S. Patent No. 5,857,175 to *Day et al.* (hereinafter "Day").

In the Decision, the Board held that Daniel "does not disclose a data transfer based on a predetermined number of purchases" and therefore does "not sustain the rejection of claim 55 under Section 103." [Decision, pgs. 5, 6].

*Solely* in an effort to expedite prosecution of this application, and in no way acquiescing in the propriety of the affirmed rejections, independent claims 1 and 24 have each been amended to recite features similar to features recited by claim 55, the rejection of which was not sustained by the Board.

In particular, independent claim 1 recites a computer implemented method that includes, *inter alia*: "receiving an identification of a purchased item and a price paid for the purchased item from a retailer **after a predetermined number of purchases** have been made at the retailer." Independent claim 24 recites a system of providing prices paid for purchased items that includes, *inter alia*: "a central computer...configured to: receive from the retail store an identification of a purchased item and a price paid for the purchased item **after a predetermined number of purchases** have been made at the retailer."

As previously noted, the Board held that "Daniels does not disclose a data transfer based on a predetermined number of purchases." None of the remaining references relied upon by the Examiner cure at least this deficiency of Daniels. Each of independent claims 1 and 24 have been amended to include recitations similar to the foregoing feature. Accordingly, the rejection of independent claims 1 and 24 under 35 U.S.C. § 103(a) is improper and should be withdrawn.

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Dependent 2-22, 25-39, 50, and 51 are allowable because they depend from allowable independent claim 1 or 24, as well as for the further features that they recite.

#### CONCLUSION

Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,

Date: June 4, 2012

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